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Supreme Court of the United States

October Term, 1969

No. 445

STANDARD INDUSTRIES, INC.,
Petitioner,

v.

TIGRETT INDUSTRIES, INC., *et al.*,
Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

PETITION FOR CERTIORARI FILED AUGUST 8, 1969
CERTIORARI GRANTED OCTOBER 27, 1969

PETITIONER'S REPLY BRIEF

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This short Reply Brief is being submitted to clarify the situation with respect to, "file wrapper estoppel" involved in the Claims of the Patent in suit.

This Reply Brief also discusses the Respondent's contention that Petitioner could have contested the validity in the Patent involved, even prior to the decision in *Lear* v. *Adkins*, 89 Supreme Court 1902.

POINT I

File wrapper estoppel is clearly present in this case.

Point III of the Respondent's Brief, in reply to Petitioner's Brief, deals with this issue.

As correctly stated in Respondent's Brief, original Claim 4 was the only original Claim which had the language, "a pair of spaced openings". In Petitioner's Brief the statement is made as follows:

> "* * * it is noted that original Claim 4 of the Application which matured into the Patent involved did not contain this limitation and was rejected by the Examiner upon the Patent to Adamson, in view of the Patent to May * * *."

The term, "a pair of spaced openings" as utilized by Petitioner in its Point II referred to the *complete phrase* which appears in Claim 1 of the Patent in suit and reads as follows:

> "* * * **said base plate having a pair of spaced openings, said draw strings being threaded upwardly through said openings in said base plate and being mutually fixedly engaged above base plate for providing a grip for convenient manipulating for said netting to elevate said base plate by upward pulling on said grip** * * *".

The limitation involved must, of course, be read as including *the entire quoted phrase* and not the commencement thereof which consisted merely of the words, "a pair of spaced openings".

As pointed out by Petitioner in his Point II, the Examiner rejected the *original* claim which *merely* included the initial words, "a pair of spaced openings" without the remainder of the phrase, on Adamson and May. Therefore, the Respondent, in soliciting the Patent involved *deliberately* placed the quoted limitational phrase in his Application in order to avoid a rejection by the Patent Office Examiner.

It is noted that the limited phrase in the allowed Claim requires that draw strings be threaded upwardly through

openings and then must be mutually fixedly engaged above the base plate. The words, "*openings in said base plate*" were, concededly, put into the Application in response to a rejection by the Primary Examiner and, indeed, the Respondent concedes that the portion of the phrase, "said draw strings being threaded upwardly through said openings in said base plate and being mutually fixedly engaged above said base plate" constitutes language which is subject to the doctrine of "file wrapper estoppel".

It is also interesting to note that original Claim 3, if it had been allowed, would have been "infringed" by the Petitioner's structure since this Claim merely requires that a flexible netting surround the base plate and that the netting at its lower end be extended inwardly beneath the base plate.

It is therefore respectfully submitted that, based upon Respondent's own argument, "file wrapper estoppel" is clearly present in this case.

POINT II

Petitioner could not have contested the validity of the patent in suit prior to the decision of this Court in *Lear* v. *Adkins*, *supra*.

In Respondent's Point IV, it is claimed that the Petitioner could have contested the validity of the Patent in suit, even though *Lear* v. *Adkins*, *supra*, had not yet been decided. As pointed out in Petitioner's Main Brief, the law in the Sixth Circuit, *at the time of the trial*, was clearly to the effect that Petitioner could not contest the validity and that it could only introduce prior art to *narrow* the scope of the Claims. The anticipating prior art that Petitioner had in its possession, at the time of the trial, showed that the use of draw strings passing upwardly through a member in order to tighten the draw

attack against the member, was old. This prior art would not have served to *narrow* the Claims but, would have *invalidated* them. Therefore, the prior art involved could not have been introduced by Petitioner under any of the former exceptions permitted.

Nor could Petitioner have introduced evidence of invalidity upon the ground of "evasion." The "evasion" cases cited by Respondent involve a situation where validity of a patent has already been *[illegible]* and prior to the assertion of such defense. This is clearly shown in *Brackett Chemical Co. v. Chesebrough Co.*, 69 Fed. 2nd 953 (cited by Respondent), where the Court said,

> "... that the decision of the District Court for the Southern District of New York on September 11, 1928, was a practical eviction of the Brackett Chemical Company from the enjoyment of the monopolistic rights granted under the license; that the appellant is not estopped to set up such eviction, and, in view of the notice thereof given, the obligation to pay royalties should cease as of the date of such decision, but that all royalties accrued prior to that date must be paid. ..."

(Emphasis supplied.)

CONCLUSION

The complaint herein should be dismissed and Petitioner granted the relief requested.

Respectfully submitted,

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